

Appl. No. 09/925,135
Amdt. dated April 26, 2005
Reply to Final Office Action of January 27, 2005

AFTER FINAL EXPEDITED PROCEDURE
REMARKS

Claims 1 to 21 were pending in the application at the time of examination. Claims 14, 15 and 18 stand objected to. Claims 1 to 18 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 14 and 15 stand rejected under 35 U.S.C. § 101. Claims 1 to 13, 16, 17, 19 and 21 stand rejected as anticipated.

Prior to considering each of the rejections in detail, Applicant respectfully requests withdrawal of the final designation on the pending action as premature. Claims 14 and 15 stand rejected under 35 U.S.C. § 101 as directed to an abstract idea. This rejection was presented for the first time in the final action. The MPEP directs:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims

MPEP § 706.07(a), 8th Ed., Rev. 2, p. 700-74 (May 2004). The support given for this rejection was "Data structure not claimed as embodied in computer-readable media is descriptive per SE." While in the prior office action response Applicant amended Claims 14 and 18 by moving the preamble into the body of the claim, original Claims 14 and 18 also did not recite anything concerning a memory or other computer-readable media. Accordingly, this rejection could have been made against the original claims, and so the amendment to Claims 14 and 18 did not necessitate the § 101 rejection. Thus, based upon the above quotation from the MPEP, the final action is premature. Accordingly, Applicant respectfully submits that the final designation should be withdrawn.

Claim 14 stands objected to for an informality. The Examiner requested that "and" in line 12, after "address" be deleted. Applicant respectfully points out that Claim 14 recites:

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a plurality of data elements . . . ;and
a link element . . .

Claim 14 further recites that

each data element comprises:
an end-of-list flag;
an end-of-section flag;
an address field having a data segment
address; and
a length field having a data segment
length

This is of the form, "element I comprises A; B; C; and D. Accordingly, Applicant respectfully submits that the "and" in line 12 is quite proper and necessary. Therefore, Applicant requests reconsideration and withdrawal of the objection to Claim 14.

Applicant will not break Claims 15 and 18 down in the same detail as Claim 14, but the "and" objected to in each instance is necessary to complete a series of subelements of an element in the same matter as explained for Claim 14. Therefore, Applicant requests reconsideration and withdrawal of the objections to each of Claims 15 and 18.

Claims 14 and 15 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant has amended these claims to recite that the elements are stored in a memory, which is one form of a computer readable medium. Accordingly, Applicant requests reconsideration and withdrawal of the § 101 rejection of Claims 14 and 15.

Claims 1 to 18 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant first notes that the Examiner was able to properly interpret the claims and to determine the claims' boundaries. Also, while Applicant does not agree with the § 112, second paragraph rejections, and could go through each claim and show that the grammar is proper,

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Applicant has amended the claims to move the prosecution forward. Specifically, each of Claims 1, 14, 15, and 18 has been amended to make it clear that a linked list is comprised of a plurality of scatter/gather list sections, and the plurality of scatter/gather sections are stored in a memory. In addition, "said plurality" has been amended to recite "said plurality of scatter/gather list sections."

Applicant respectfully requests entry of the amendments to the Claims. The amendments were not earlier presented because the amendments are directed to rejections that were first raised in the final office action. Also, the recitation in the amended claims is equivalent to that in Claims 16 and 18 for example, and so does not require consideration of new issues or a new search. Entry of the amendments is proper, because the amendments overcome the rejections and so place the claims in condition for allowance in view of the following remarks. If the Examiner should disagree, the Examiner is respectfully requested to enter the amendments to narrow the issues of appeal.

Claims 1 to 13, 16 to 17, and 19 to 21 stand rejected as anticipated by Applicant's admitted prior art. Specifically,

As to claim 1, Applicant's admitted prior art (Specification pages 1-3 and fig. 1A-1C) discloses the claimed "a plurality of scatter/gather list sections stored in a memory" a scatter/gather list stored in memory 115 (fig. 1A-1 B) includes a plurality of sections 130A and 130B, "wherein at least one scatter/gather list section" the scatter/gather list sections 130A and 130B, comprising: "a plurality of data elements" the data elements 130_1A to 130_nA in list 130A and the data elements 130_1B to 130_nB in list 130B (fig. 1A-1B), wherein each data element 130_1A to 130_nA in list 130A, and wherein the plurality of scatter/gather list 130A to 130B has a structure as illustrated by list section 130C in fig. 1C, and wherein list section 130C includes a plurality of elements 1401 to 140_(n+1), each of elements 1401 to 140_(n+1) includes an end-of-section flag a1 and an end-of-list flag y1 (see fig. 1 C).

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Applicant respectfully traverse the anticipation rejection of Claim 1. As best that the rejection is understood, the rejection combines Figs. 1A to 1C to arrive at Applicant's invention as recited in Claim 1. However, each of Figs. 1A to 1C is an example of a different prior art approach to implementing scatter/gather lists. In particular, the specification described:

Fig. 1A is an illustration of a prior art host adapter system with a scatter/gather list, in contiguous memory locations, which used a list length variable.

Fig. 1B is an illustration of a prior art host adapter system with a scatter/gather list, in contiguous memory locations, which used an end list flag bit.

Fig. 1C is an illustration of a prior art host adapter system with a scatter/gather list in discontinuous memory locations that used a list length variable and a section length variable.

Specification, pg. 7, lines 5 to 16.

Thus, the description unambiguously establishes that Figs. 1A to 1C are three different examples. The description provides no basis for selecting elements from the various different examples to generate a new scatter/gather list.

In addition, it is well known that elements in the prior art scatter/gather lists included an address and length of a data segment. See Specification, pg. 2, lines 8 to 12. The quoted description above makes it clear what information was used in addition to the elements that included an address and a data segment length. Thus, in Fig. 1C, a1, a2, etc. are addresses, while y1, y2, etc. are corresponding data segment lengths.

The Examiner has failed to cite any teaching or description in the specification that characterizes a1 as an end-of-section flag. In fact, the admitted prior art does not include the phrase "end-of-section flag." Each element in the prior art examples that is different from an address and a data segment length has been explicitly called out and

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defined. The description provides no basis for assigning definitions different from those that would be used by those of skill in the art. In addition, a scatter/gather list section that included only end-of-section and end-of list flags would not function as a scatter/gather list, and so this is but further evidence that the interpretation used in the rejection is not supported by the cited prior art.

The MPEP requires:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
... "The identical invention must be shown in as complete detail as is contained in the ... claim."
... The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

MPEP § 2131, 8th Ed., 2nd Rev. p. 2100-73 (May 2004).

The fact that elements from three different figures were selected and then recombined in the rejection shows that the reference fails to have "The elements . . . arranged as required by the claim." Further, since an "end-of-section flag" is not described in the cited prior art, the cited prior art fails to show the invention in as complete detail as contained in the claim. Therefore, Claim 1 distinguishes over the cited prior art. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 1.

Claim 2 to 13 depend from Claim 1 and so distinguish over the combination of references for at least the same reasons as Claim 1. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 13.

Claims 16, 17 and 19 to 21 include limitations similar to those discussed above with respect to Claim 1 and so that discussion is incorporated herein by reference. Accordingly, Applicant requests reconsideration and

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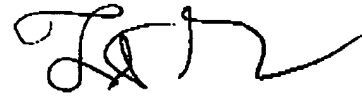
withdrawal of the obviousness rejection of each of Claims 16, 17, and 19 to 21.

Claims 1 to 21 remain in the application. Claims 1, 14, 15, 16, and 18 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

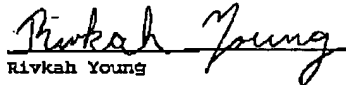
CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306, on April 26, 2005.

Respectfully submitted,



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